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10/092,685	03/07/2002	Shin Chai Mark Lin	2002P03667 US	3816

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170 Wood Avenue South
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EXAMINER

DABNEY, PHYLESHA LARVINIA

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/092,685
Filing Date: March 07, 2002
Appellant(s): LIN, SHIN CHAI MARK

Joel Miller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 6, 2008.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Claimed Subject Matter*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

6,678,386 Robinson et al 01-2004

embedded. Answers.com. The American Heritage® Dictionary of the English Language, Fourth Edition, Houghton Mifflin Company, 2004.
<http://www.answers.com/topic/embedding>, accessed May 21, 2008.

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al (U.S. Patent No. 6,678,386). This rejection is set forth in the prior Office Action, mailed on November 1, 2007.

Regarding claims 1, 5, and 9, Robinson teaches a modular assembly for a hearing instrument comprising: a faceplate (10), a battery door (101, 140) in the faceplate; and an electrical programming contact assembly (200-220, 300-340; fig. 2-4) partially affixed to the faceplate and generally adjacent and conforming to the contour of the battery door, where the electrical programming contact assembly is partially embedded in the faceplate.

Regarding claims 2, 4, 6, 8, 10, and 12, Robinson teaches the faceplate comprises a generally rectangular opening; and a battery door resides within the generally rectangular opening (fig. 1).

Regarding claims 3, 7, and 11, Robinson teaches the electrical contact assembly comprises at least one contact (320), where each contact comprises a contact portion (the portion

extending from 308) and a terminal portion (326) generally adjacent and conforming to the contour of the battery door, and an interconnection portion (the curved portion of 320), interconnecting the contact and terminal portions, where the interconnecting portion is at least partially embedded in the faceplate.

(10) *Response to Argument*

With respect to the Appellant’s arguments that the Robinson reference does not disclose, teach or suggest *an electrical programming contact assembly partially affixed to the faceplate and “generally” adjacent and conforming to the battery door* as presented in claims **1, 5, and 9**.

Robinson does show the electrical ...contact assembly (200-220, 300-340, figs. 2-4) *generally* adjacent and conforming to the battery door by showing for example in figures 2-3, the contact assembly portions (300-340) clearly touching the battery door portion (101, 140) as depicted below.

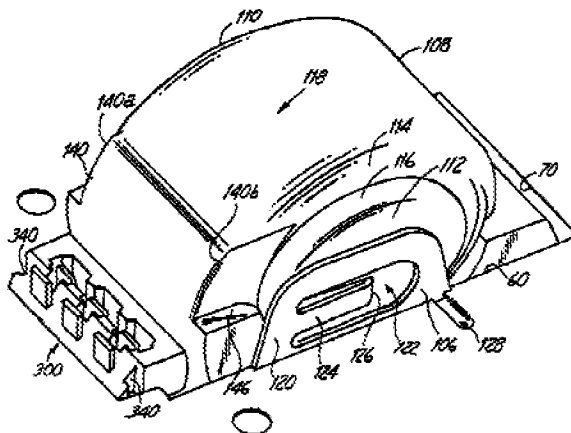


FIG. 3

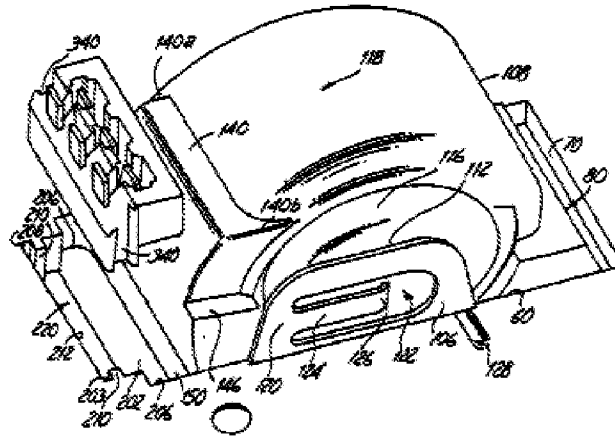


FIG. 2

With respect to the Appellant's arguments that the Robinson reference does not disclose, teach or suggest *an electrical programming contact assembly, "partially embedded in the faceplate"* as presented in claims **1, 5, and 9**, the Examiner disagrees.

The Appellant argument is reflected in the two excerpts cited below, wherein it is stated that the faceplate "can be" fabricated by injection molding, and the contact assembly (terminal portions is part of the contact assembly) is embedded within the faceplate.

(Applicant's specification page 2, line 17 through page 3, line 2) Although the programming contact assembly 30 shows three distinct contacts 40, 50, and 60, any number of contacts could have been provided. The faceplate 10 can be fabricated by injection molding, during which the battery support contacts 22 and the programming contact assembly 30 are held in place.

(Applicant's specification page 3 line 16 through page 4 line 2) The contacts 40, 50, and 60 have intermediate interconnection portions 46, 56, and 66 between the respective contact and terminal portions. As shown in Figure 1, at least a portion-of each of the interconnection portions 46, 56, and 66, and

possibly portions of the contact portions 42, 52, and 56, and the terminal portions 44, 54, and 64 are embedded within the faceplate 10.

Relative to the **first excerpt**, the recitation "can be fabricated by injection molding" is not included in the claims and for the reason stated here was not incorporated into the claimed invention [MPEP 2111.1, section II]. Specifically, it is deemed improper to import claims limitations from the specification. "Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). See also *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)(discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment);[<] *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) ("Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims in view of the specification' without unnecessarily importing limitations from the specification into the claims."); *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) (Although the specification discussed only a single embodiment, the court held that it was improper

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to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order).

Further, if the Appellant intends to have a special meaning, then the special meaning must set forth the definition explicitly and with “reasonable clarity, deliberateness, and precision” in the disclosure to give one of ordinary skill in the art notice of the change/intent. Since there is not a special meaning in **excerpt one**, it would not be permissible to include the special meaning in a reasons for allowance (if applicable).

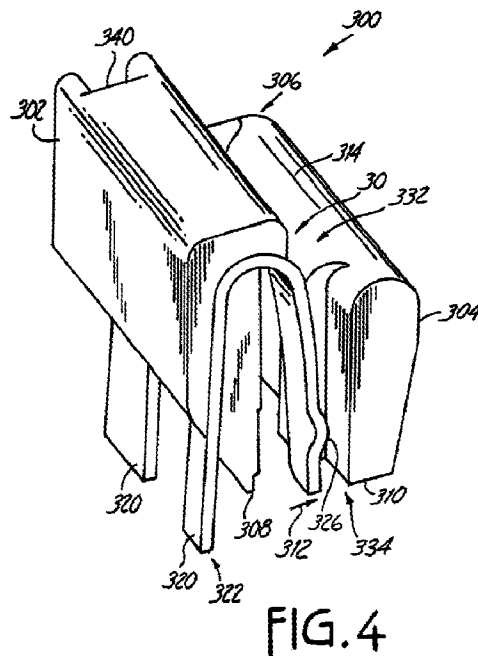
Relative to the **second except**, the recitation "terminal portions...are embedded within the faceplate". The term “embed” is defined as “to fix into a surrounding mass; to surround tightly or firmly; envelop or enclose.”

Robinson teaches slot (220) of the faceplate (10) being used to hold [affix or surround] and embed the contact assembly (300-340) within itself.

With respect to the Appellant’s arguments that the Robinson reference does not discloses, teach or suggest *an electrical contact having an interconnecting portion at least partially embedded in the faceplate, “generally” adjacent and conforming to the battery door* as presented in claims **3, 7, and 11**, the Examiner disagrees.

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Robinson does teach an interconnection portion (the curved portion of 320) including a contact portion (the portion extending from 308) and a terminal portion (326) as depicted below in figure 4 which is part of the contact assembly (300-340), at least partially embedded in the faceplate, “generally” adjacent and conforming to the battery door by showing the contact assembly clearly touching the battery door portion (101, 140)).



With respect to the Appellant's arguments that the Robinson reference does not disclose, teach or suggest *a contact [electrical programming contact assembly] affixed to the faceplate*, the Examiner disagrees.

Robinson teaches the slot 220 of the faceplate 10 is used to hold [affix] the contacts (300-340, figs. 2-4) to the faceplate (col. 4 lines 59-60).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Phylesha L Dabney/
Examiner, Art Unit 2614
June 10, 2008

Conferees:

/Curtis Kuntz/

Supervisory Patent Examiner, Art Unit 2614

/Vivian Chin/

Supervisory Patent Examiner, Art Unit 2615